

Application No.: 10/526,108
Attorney Docket No.: 47675-102
First Applicant's Name: Sabine Maier
Application Filing Date: 10 May 2006
Office Action Dated: 11 January 2008
Date of Response: 11 July 2008
Examiner: Amanda Marie Shaw

REMARKS

Claims 1-37 and 40 are pending and subject to restriction.

Group election:

The Examiner is requesting an initial election of one Group of claims from among:

Groups I (claims 1-2, 17, 20-21, 23-26, 31-35);

Group II (claims 3-9, 36-37, 40); and

Group III (claims 13-15).

Additional election:

With respect to all Groups, the Examiner is additionally requesting a “species” election of a single sequence or a single combination of sequences selected from the group consisting of SEQ ID NOS: 1-370:

Election

Applicants elect **Group I** (claims 1-2, 17, 20-21, 23-26, 31-35), additionally elect SEQ ID NO: 366 corresponding to the gene Calcitonin, **with traverse**.

Applicant's traversal:

As disclosed in the specification at pages 2, 3, 6, 7, 15, and 16, in particular aspects the genomic DNA sample is treated in such a manner that cytosine bases which are unmethylated at the 5'-position are converted to uracil, thymine, or another base which is dissimilar to cytosine in terms of hybridization behavior. It is preferred that this treatment is carried out with bisulfite (hydrogen sulfite, disulfite) and subsequent alkaline hydrolysis.

Therefore, SEQ ID NOS: 367-370 should be grouped and examined together with SEQ ID NO:366 because they correspond to bisulfite-treated sequences for the identical sequence region of genomic SEQ ID NO:366. Specifically, SEQ ID NOS:367 and 369 are chemically (bisulfite) treated sequences of the sense strand of SEQ ID NO:366 and SEQ ID NOS:368 and 370 are chemically treated sequences of the *complementary* antisense strand of SEQ ID NO:366 (that is, of the identical sequence region of genomic DNA), and the patentability of claims limited by these

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SEQ ID NOS will be determined based, *inter alia*, on the novelty of analysis based on this genomic sequence region for the claimed indications.

In summary, Applicant points out that it has been the consistent practice of the Office to group the bisulfite-treated sequences with the underlying genomic sequence in a single group. Applicant, therefore, respectfully submits that **the elected group should be Group I, Calcitonin (SEQ ID NO:366, 367-370)**. This is because the patentability of the claims limited by these SEQ ID NOS will be determined based, *inter alia*, on the novelty of analysis based on the genomic sequence region SEQ ID NO:366, corresponding to Calcitonin.

Claim Amendments

Improper dependent form. Claims 10, 11, 12, 16, 18, 19, 22, 27, and 36 have been amended by Applicant to remove the improper multiple dependencies. Applicant respectfully contends that claims 28-30 are proper as previously presented. Particular claims have been amended per the sequence elections made herein.

No new matter has been added.

Conclusion

Applicant respectfully requests entry of the present Response and Amendment, and submits that the elected group should be Group I, Calcitonin (SEQ ID NO:366, 367-370).

Respectfully submitted,
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